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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,055	06/06/2001	Yoko Iwamiya	208853US0	5631

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EXAMINER

METZMAIER, DANIEL S

ART UNIT PAPER NUMBER

1712

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/874,055	<b>Applicant(s)</b> IWAMIYA ET AL.	
	<b>Examiner</b> Daniel S. Metzmaier	<b>Art Unit</b> 1712	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): the rejection of claims 6-7 and 12-13 over Smith, US 3,962,500.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1,2,5-8 and 11-13.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_
13. ☒ Other: See attached.

### DETAILED ACTION

Claims 1-2, 5-8, and 11-13 are pending and are rejected over the outstanding rejections.

1. The examiner acknowledges applicants' comments (page 9 of the response filed April 12, 2005<sup>1</sup>) regarding the Bank et al reference and the withdrawal thereof. See applicants' amendments incorporating claim 4 into the independent claims. Note, claim 4 was not included in the rejection over the Bank et al reference.

2. Applicants (page 9) summarize the invention.

3. Applicants (page 10) traverse the rejection over Smith. The rejections and/or the response to arguments address applicants' prior traversals. Applicants' arguments are based on the premise that "the main component" limits the concentrations of formula 1 in claims 1 and 8. This is clearly responded to in paragraph 9 of the Final Office Action.

4. Applicants assert (page 11) that claims 1 and 8 positively recite concentrations by the limitation, "as the main component". This has not been deemed persuasive for the following reasons:

(1) Applicants amended the claims on March 25, 2004 to limit the claimed formula 1 to the characterization, "as a main component". Applicants asserted (March 25, 2004, page 9) support for the amendment was in the original claim 1 and the originally filed page 12, line 3, to page 13, line 4. A review of said citation in the specification shows reference to "the main component" is that of formula 1 relative to

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<sup>1</sup> All references to applicants' response with refer to the April 12, 2005 response unless specifically noted.

further condensation products of formula 1 (i.e., the subscript  $n = 2-10$  relative compounds greater than  $n = 10$ ) and **not** formula 1 relative to formulae 2<sup>2</sup> and/or 3.

(2) The specification does not specifically define the limitation, “the main component”.

(3) The dictionary defines “main” as the most important or principal. Said definition denotes a level of importance rather than amount (i.e., concentration) and absent a specific recitation in the specification is not a limitation on concentrations.

(4) Applicants (response filed March 25, 2004, page 15, line 1) assert that “the main component” defines “the concentration of formula 1 is at least 50% (i.e., the ‘main component’)”. Applicants have provided no basis in the original specification for said interpretation since said interpretation cannot be found in applicants indication for support indicated (March 25, 2004, page 9).

(5) Applicants (page 10 of the response filed September 29, 2004) assert “the silane-based coating solution contains the claimed silane as the main component (i.e., the component that is present in the greatest amount, which is not necessarily greater than 50% as previously argued).” Said statement is repeated at page 12 of the instant response. It is unclear where applicants are relying in the originally filed specification for their interpretation of said ranges.

(6) Claims must be given their broadest reasonable interpretation consistent with the specification during examination. See MPEP § 2111.

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<sup>2</sup> It is noted for the record that formula 2 reads on the starting material, i.e., unhydrolyzed and condensed, formula 1.

In conclusion, applicants' claims are clearly not commensurate in scope with their arguments presented. Said arguments are not deemed probative.

5. Applicants (page 12) assert the Smith reference does not disclose the compounds having the subscript,  $n = 2-10$ . Smith clearly discloses compounds of formula 2 and partial hydrolysates thereof. The partial condensates would have been expected and noted at page 12, line 3, to page 13, line 4, of the instant specification, the condensation products clearly include those having  $n = 1$  or greater than 10 as long as those having a subscript of  $n = 2-10$  are the main component.

It is further noted that applicants have shown no difference between the partial hydrolysates/condensates and the instantly claimed compositions. The claims are a representation of an actual composition and need not recite the claims *ipso verba*.

Applicants (page 12) assert the examiner has repeatedly left the above issue unaddressed. A fair reading of the rejection over Smith shows that applicants statement is clearly erroneous since the rejection states that the Smith reference teaches partial hydrolysis and condensation would have been expected. It is further noted that the components are expected to exist as an equilibrium reaction mixture, i.e., including starting materials, partial hydrolysates, condensates, which would include oligomers. Smith (column 3, lines 22-27 and examples) clearly teaches hydrolysis and condensation and the Smith reference to partial condensates in the examples.

6. Applicants' (page 12) assertion regarding the limitation, "the main component (i.e., the component that is present in the greatest amount, which is not necessarily greater than 50% as previously argued)" has been addressed above. It is emphasized

that applicants have presented multiple interpretations for said limitation but have provided no clear indication in the original specification for any of said concentration interpretations thereof.

7. The rejections of claims 6-7 and 12-13 have been withdrawn in view of the relative concentrations of formulae 2 and/or 3 does not exceed 50% of the amount of formula 1. Said embodiment is but several disclosed. Said limitation has basis on instant page 22 and requires that the compounds of formula 1 be in a concentration of greater than about 66.6% (interpreted as wt% based on Tables 1 and 2) since 50% by wt of formulae 2 and 3 of 66.6 gm (66.6 %) of formula 1 is about 33.3 gms, wherein formula 1 + 2 + 3 ~ 100 gm (100 %).

8. Applicants' conclusion (A) regarding the condensate degree has been addressed in the rejection and herein above. Applicants' conclusion (B) regarding the concentrations has been addressed in the rejection and herein above.

9. Applicants have presented an argument regarding the obviousness double patenting rejection for the first time.

The argument set forth (page 13) is that compounds of formula 1 are "the main component". This has been addressed above regarding Smith.

Applicants further argue (page 14) that page 22, line 15, to page 23, line 7, details problems of using increasing amounts of compounds of formula 2. Applicants' arguments are misplaced since '183 sets forth in the claims that compounds of formula 2 denoted in '183 as (B) is optional. Optional is interpreted as only compounds of formula 1 are present in the coating. Attention is further directed to Tables 1 and 2 of

'183 wherein the compounds of formula 2 are in a minor amount. "The specification can always be used as a dictionary to learn the meaning of a term in the patent claim. *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968).".

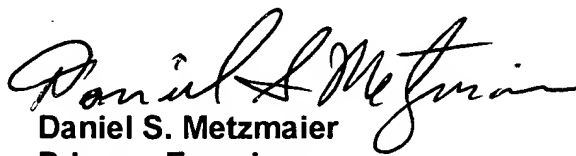
10. Claims 1-2, 5, 8 and 11 are deemed properly rejected. Said rejections have been maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel S. Metzmaier  
Primary Examiner  
Art Unit 1712